



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/716,274 | 11/18/2003 | Maxwell S. DeHaven | 10014429-2 | 6053 |

7590 12/02/2004
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

EVANS, ANDREA HENCE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2854

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,274

Applicant(s)

DEHAVEN, MAXWELL S.

Examiner

Andrea H. Evans

Art Unit

2854

AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/18/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 24-26 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 24-26 are non-limiting. The claims do not add any structure to claim 19. Each of these claims is directed to the copper, which is not a positively claimed element.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Piatt (4991287).

Referring to claim 14, Piatt teaches a printer (20) comprising an adjustable feeding mechanism (See Column 2, lines49-51) and a printing mechanism (21).

Applicant should note that claim 14 includes functional language that does not define sufficient structure to patentably distinguish the claim from the prior art. For example, Applicant does not positively claim the inverse circuit image.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Piatt in view of Rouberol (6379569).

Referring to claim 15, Piatt teaches all that is claimed as discussed above. Piatt does not teach that the printer utilizes water-insoluble ink. Rouberol uses water-insoluble ink (See Column 2, lines 51-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use water insoluble ink so that the ink is more resistant as taught by Rouberol.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Piatt in view of Filo (5334836).

Referring to claim 16, Piatt teaches all that is claimed as discussed above. Piatt does not teach that the printer utilizes India ink. Filo teaches the use of India ink. (See Column 5, lines 69- Column 6, line 2). It would have been obvious to one having ordinary skill in the art at the

Art Unit: 2854

time the invention was made to use India ink so that the ink will have better optical properties as taught by Filo.

7. Claims 17-19 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piatt in view of Cooper et al (5774141).

Referring to claims 17 and 22, Piatt teaches an adjustable feed system (See Column 2, lines 49-51). Piatt does not teach that the adjustable feeding mechanism includes at least two settings; a first setting to feed paper through a printing process and a second setting to accommodate a substrate having a predetermined size. Cooper teaches a printer that has an adjustable feeding mechanism includes at least two settings; a first setting to feed paper through a printing process and a second setting to accommodate a substrate having a predetermined size. (See Column 3, lines 64-Column 4, line 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the feeding mechanism of Piatt to include two settings in order to accommodate different size substrates as taught by Cooper.

Referring to claim 18 and 23, Piatt teaches all that is claimed as discussed above. Piatt does not teach that the two settings include a plurality of settings. Cooper teaches a plurality of settings (See Column 3, lines 65-66). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of settings in order to provide printer options to the operator as taught by Cooper.

Referring to claim 19, Piatt teaches a printer (20) comprising an adjustable feeding mechanism (See Column 2, lines 49-51) and a printing mechanism (21). Piatt does not teach that the feeding mechanism is a flat input feeder. Cooper teaches a flat input feeder (26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to

Art Unit: 2854

replace the feeder of Piatt such that it is a flat input feeder for better storage of the substrate to be printed.

Applicant should note that claim 19 includes functional language that does not define sufficient structure to patentably distinguish the claim from the prior art. For example, Applicant does not positively claim the inverse circuit image.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Piatt in view of Cooper and further in view of Rouberol (6379569).

Referring to claim 20, Piatt and Cooper teach all that is claimed as discussed above. They do not teach that the printer utilizes water-insoluble ink. Rouberol uses water-insoluble ink (See Column 2, lines 51-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use water insoluble ink so that the ink is more resistant as taught by Rouberol.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Piatt in view of Cooper and further in view of Filo (5334836).

Referring to claim 21, Piatt and Cooper teaches all that is claimed as discussed above. They do not teach that the printer utilizes India ink. Filo teaches the use of India ink. (See Column 5, lines 69- Column 6, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use India ink so that the ink will have better optical properties as taught by Filo.

Art Unit: 2854

Conclusion

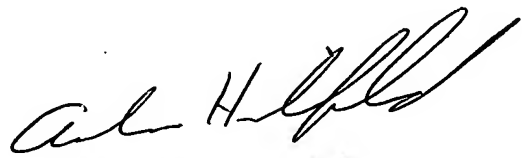
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea H. Evans whose telephone number is (571) 272-2162. The examiner can normally be reached on Monday- Friday; 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrea H. Evans

AHE



ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800